Supreme Court, U.S.
FILED
NOV 6 1980
MICHAEL RODAK, JR., CLERK

No. 80-546

IN THE

Supreme Court of the United States

OCTOBER TERM, 1980

STUDIENGESELLSCHAFT KOHLE M.B.H., as Trustee for the Max-Planck-Institut für Kohlenforschung,

Petitioner,

—against—

EASTMAN KODAK COMPANY,

Respondent.

PETITIONERS REPLY BRIEF ON ITS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

ARNOLD SPRUNG
NATHANIEL D. KRAMER
SPRUNG FELFE HORN LYNCH & KRAMER
600 Third Avenue
New York, New York 10016
Attorneys for Petitioner

In the

Supreme Court of the United States

October Term, 1980

No. 80-546

Studiengesellschaft Kohle m.b.H., as Trustee
for the Max-Planck-Institut für Kohlenforschung,

Petitioner,

—against—

Eastman Kodak Company,

Respondent.

PETITIONERS REPLY BRIEF ON ITS PETITION FOR CERTIORARI

Respondent, in opposition to the Petition for a Writ of Certiorari, primarily argues not the case at bar, but rather an earlier case, *Ziegler* v. *Phillips Petroleum Company*, 483 F.2d 858 (5th Cir. 1973), ignoring the fact that the Fifth Circuit specifically found, in the instant case, that the *Phillips* decision was not a "basis for estoppel in the present case." (Appendix at 32a)

Respondent furthermore ignores the fact that in the earlier *Phillips* case, there was no separate "making" of the catalyst, as the catalyst was formed as an integral part of the overall process, which undoubtedly contributed to the court's conclusion therein that the same had process characteristics. (Petition at 4, n.3)

Respondent further argues that the Fifth Circuit held that its catalyst composition does not infringe the '332

composition patent claims, as the Court found that defendant was not using the composition of the catalyst of the '792 patent. The '792 patent, however, is a process patent, and the Court of Appeals found non-infringement on the basis of a number of *process* differences, cautioning that "no single factor by itself" was sufficient to avoid infringement of the '792 process patent. (Appendix at 54a)

Finally, the issue of whether respondent infringed the '332 patent by making and using the claimed catalyst was a primary issue raised and considered in the proceedings below.

Respectfully,

ARNOLD SPRUNG
NATHANIEL D. KRAMER
SPRUNG FELFE HORN LYNCH & KRAMER
600 Third Avenue
New York, New York 10016
Attorneys for Petitioner